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DEC 11 2006

OFFICE OF PETITIONS

In re Application of :
Shade et al. : DECISION ON APPLICATION
Application No. 09/964,293 : FOR
Filed: September 25, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. 07844-469001 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR \$1.705(B)," filed July 10, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred ninety-four (194) days to one thousand one hundred thirty-five (1135) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **nine hundred sixty-six (966)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On April 11, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 194 days. On July 10, 2006, applicants timely¹ submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is 1135 days.

¹ PALM records indicate that the Issue Fee payment was also received on July 10, 2006.

Applicants dispute the reduction of 772 days, associated with the filing of a response on March 8, 2004 to the Office Notice mailed October 26, 2001. Applicants assert that there was no applicant delay as the response filed March 8, 2004 was filed with a petition showing that the response should be considered filed December 20, 2001. Further, applicants dispute the reduction of 66 days associated with the filing of an Information Disclosure Statement (IDS) on December 27, 2005. Finally, applicants maintain that the Office delay pursuant to 1.702(a)(1) should be 1135 days, not 1032 days. Applicants assert that this Office delay should be calculated based on the mailing of a second first Office action on January 3, 2006, rather than the mailing of a first Office action on September 22, 2005. Applicants argue that the mailing of an Office action on September 22, 2005 should not be used as applicants were advised of an error in the first Office action and the examiner indicated that the case "will need to be examined from the start again" thereby resetting the clock for the first Office action.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

With respect to the 772-day reduction, applicants are correct that the reduction is not warranted. Applicants established on petition filed March 8, 2004 that their response to the Notice mailed October 26, 2001 was filed in the Office on December 20, 2001. As this was within the three-month period provided for in 37 CFR 1.704(b), no reduction is warranted. The reduction of 772 days has been removed.

However, with respect to the 66-day reduction, applicants are incorrect. Applicants argue that the reduction is not warranted because the art was cited in an Office Action dated November 22, 2005, which is within the time limits provided to file art from a foreign counterpart application and not incur Patent Term Adjustment. Applicants' argument has been considered but not found persuasive. 37 CFR 1.704(d) provides that:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this

section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

A review of the IDS filed December 27, 2005 reveals that it was not accompanied by the §1.704(d) statement. Nor do applicants make the statement on the instant application for patent term adjustment.

It is noted that the reduction for the IDS is based on the IDS being filed after a reply had been filed on October 22, 2005. See 1.704(c)(8). It is unclear from the record whether any reply was filed on October 22, 2005 (or any other date prior to December 27, 2005) to the first Office action mailed September 22, 2005. Thus, removal of the reduction of 66 days may be warranted if a proper §1.704(d) statement is made or if it is shown that the circumstances of the filing of the IDS did not constitute a failure to engage within the meaning of §1.704(c)(8) or any other provision of the rules.


Finally, with respect to the period of adjustment of 1032 days, applicants are incorrect. A review of the application history confirms that the Office mailed a first action under 35 U.S.C. 132 on September 22, 2005. In this case, the mailing of an Office action on January 3, 2006 does not alter the date used in calculation of the period of adjustment. The Office met the requirement of 35 U.S.C. 154(b) with the mailing of this Office action. This action was issued as a result of the examination conducted pursuant to 35 U.S.C. 131. In this instance, the circumstances of the examiner determining that the application had to be examined again does not negate the conclusion that an Office action under 35 U.S.C. 132 was mailed on September 22, 2005 as a result of examination conducted pursuant to 35 U.S.C. 131. Thus, for purposes of calculating patent term adjustment pursuant to 37 CFR 1.703(a)(1), the date of mailing of a first action under 35 U.S.C. 132 is September 22, 2005. This is beyond 14 months of the filing date of the application, September 25, 2001. Thus, a period of adjustment pursuant to 1.702(a)(1) of 1032 days was properly entered.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is nine hundred sixty-six (966) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Publications Division for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM Screen

Day : Tuesday
Date: 12/5/2006

PALM INTRANET

Time: 13:05:21

PTA Calculations for Application: 09/964293			
Application Filing Date:	09/25/2001	PTO Delay (PTO):	1032
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	838
Post-Issue Petitions:	0	Total PTA (days):	966
PTO Delay Adjustment:	772		

File Contents History					
Number	Date	Contents Description	PTO	APPL	START
60	12/05/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	772		
49	04/11/2006	MAIL NOTICE OF ALLOWANCE			
48	04/10/2006	ISSUE REVISION COMPLETED			
47	04/10/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
46	04/10/2006	NOTICE OF ALLOWABILITY			
45	12/27/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
44	02/27/2006	DATE FORWARDED TO EXAMINER			
43	02/22/2006	RESPONSE AFTER NON-FINAL ACTION			
42	12/27/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		66	38
41	01/03/2006	MAIL NON-FINAL REJECTION			
40	12/23/2005	NON-FINAL REJECTION			
39	12/23/2005	DATE FORWARDED TO EXAMINER			
38	10/22/2005	RESPONSE AFTER NON-FINAL ACTION			
37	12/20/2005	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
36	12/14/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
35	09/22/2005	MAIL NON-FINAL REJECTION	1032		-1
34	09/19/2005	NON-FINAL REJECTION			
33	09/02/2005	CASE DOCKETED TO EXAMINER IN GAU			
32	08/09/2005	CASE DOCKETED TO EXAMINER IN GAU			
31	08/05/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
30	08/05/2005	CASE DOCKETED TO EXAMINER IN GAU			

29	04/22/2005	REFERENCE CAPTURE ON IDS			
28	04/22/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
27	01/28/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
26	01/25/2005	REFERENCE CAPTURE ON IDS			
25	01/25/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
24	10/08/2004	REFERENCE CAPTURE ON IDS			
23	10/08/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
22	09/22/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
21	05/05/2005	APPLICATION DISPATCHED FROM OIPE			
20	05/06/2005	APPLICATION IS NOW COMPLETE			
19	09/25/2001	CLAIM PRELIMINARY AMENDMENT			
18	05/05/2005	ADDITIONAL APPLICATION FILING FEES			
17	04/25/2005	PRE-EXAM OFFICE ACTION WITHDRAWN			
16	04/25/2005	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
15	03/08/2004	PAYMENT OF ADDITIONAL FILING FEE/PREEXAM		772	4
14	10/26/2001	PRE-EXAM OFFICE ACTION WITHDRAWN			
10	09/25/2001	CLAIM PRELIMINARY AMENDMENT			
8	03/08/2004	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
6	04/22/2005	WITHDRAW PUBLICATION/PRE-EXAM ABANDON			
5	12/27/2001	ABANDONMENT -- DURING PREEXAM PROCESSING			
4	10/26/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
3	10/25/2001	CORRESPONDENCE ADDRESS CHANGE			
2	10/03/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	09/25/2001	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION